DOCKET NO.: MSFT-2822/305442.01
Application No.: 10/692,868
Office Action Dated: December 10, 2007

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

In summary, claims 1-25 are pending. Claims 1 and 3-25 are rejected under 35 U.S.C. 35 § 102. Claims 2, 3, 6, 7, 19, 20, 22, and 23 are rejected under 35 U.S.C. 35 § 103. Applicant respectfully traverses the rejections. Claims 1, 4, 8, and 16 are herein amended. Claims 1, 8, and 16 are amended to incorporate the structure and utilization of the trust store (Item number 206 in Figure 2) described in paragraphs [0030] - [0031] of Applicant's specification. Claim 4 is amended to indicate that the licensing component can not enforce licensing constraints on the computer program. Support for the amendment to claim 4 can be found in paragraph [0007] of Applicant's specification. No new matter is added.

Telephone Conversation With Examiner

Applicant's representative thanks Examiner Murdough for the telephone conversation conducted on January 10, 2008. Rejections under 35 U.S.C. § 112 were discussed. The finality of the Office Action was discussed. Additionally, Applicant's representative asked Examiner Murdough why some previous claim amendments were not given patentable weight. Examiner Murdough explained that the amendments, as he interpreted them, were directed to nonfunctional descriptive material. No conclusions were reached.

Claim Rejections - 35 U.S.C. §102

Claims 1 and 3-25 are rejected under 35 U.S.C. § 102 as being anticipated, either separately or in combination, by U.S. Patent Publication 200220161718 published to Coley *et. al.*, (hereinafter referred to as "Coley"), or U.S. Patent No. 5,375,206, in the name of Hunter (hereinafter referred to as "Hunter"), or U.S. Patent No. 5,563,946, in the name of Cooper (hereinafter referred to as "Cooper").

Coley, Hunter, or Cooper neither disclose nor suggest "a trust store in which dynamic data is stored in a tamper-resistant manner, wherein the dynamic data is utilizable to validate the license" as recited in amended independent claims 1 and 8, or "a trust store having stored therein dynamic data that is stored in a tamper-resistant manner and is utilizable to validate the license" as recited in amended independent claim 16.

Coley utilizes a server database accessible through the Internet, but shows no use of a trust store by the Software Licensing Service, either local or remote. Further, Coley nowhere teaches a trust store having stored therein dynamic data that is stored in a tamper-resistant manner and is utilizable to validate the license. Hunter shows a method for licensing software that includes local license monitor servers and vendor supplied remote license servers for providing a method of creating a common application software interface for licensing software, but again, no use or disclosure of a trust store or repository having stored therein dynamic data that is stored in a tamper-resistant manner and is utilizable to validate the license, is disclosed. Cooper teaches distributing software to potential users allowing a user a temporary trial period without subjecting the software to unnecessary risks of piracy or unauthorized utilization beyond the trial interval. Cooper nowhere discloses nor suggests both the claimed trust store and license store.

With respect to amended claim 4, which is rejected in view of Coley, Coley neither discloses nor suggests "the licensing component does not enforce licensing constraints on the computer program". Coley mandates that any software application having a licensing system client module attached will not operate unless and until the license system client module receives authority to enable the software application (Coley Paragraph [0054]). Further, at Coley Paragraph [0048], if the returned license ID pointer is null, the client module 108 fails to enable the software application or disables it [Step 226].

In view of the foregoing arguments and because Coley, Hunter, or Cooper neither disclose nor suggest "a trust store in which dynamic data is stored in a tamper-resistant manner, wherein the dynamic data is utilizable to validate the license" or "a trust store having stored therein dynamic data that is stored in a tamper-resistant manner and is utilizable to validate the license", it is requested that the rejection, under 35 U.S.C. § 102, of claims 1 and 3-25 to be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. §103

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Coley.

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The foregoing arguments with respect to the rejection of claim 1 under 35 U.S.C. § 102 are also applicable to the rejection of claim 2 under 35 U.S.C. § 103.

Further, a prima facie case of obviousness has not been established because the only argument in support of the rejection of claim 2 is in the form of the conclusory statement: "The act of making the program and licensing component integral would have been obvious to one of ordinary skill in the art at the time of the invention." (Page 14 of the instant Office Action).

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" (Emphasis added) MPEP § 2142.

This is further emphasized in MPEP § 706.02(j). "35 § U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 § U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made." (Emphasis added).

Also per MPEP § 706.02(j): "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear

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as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application."

In view of the foregoing amendments and arguments, and because a prima facie case of obviousness has not been established for the rejection of claim 2, it is requested that the rejection of claim 2 under 35 U.S.C. § 103 be reconsidered and withdrawn.

Claims 3, 6, 7, 19, 20, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coley in view of Hunter. And claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Coley in view of Cooper.

The foregoing arguments with respect to the rejection of independent claims 1, 8, and 16 under 35 U.S.C. § 102 are also applicable to the rejection of claims 3, 6, 7, 19, 20, and 23 under 35 U.S.C. § 103. Accordingly, it is requested that the rejection, under 35 U.S.C. § 103, of claims 3, 6, 7, 19, 20, and 23 be reconsidered and withdrawn.

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CONCLUSION

It is requested that the forgoing amendments, arguments, and remarks be entered, and in view thereof, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow this application for any reason, the Examiner is encouraged to contact the undersigned attorney to discuss resolution of any remaining issues.

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/Joseph F. Oriti/
Joseph F. Oriti
Registration No. 47,835

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439